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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/556,531

11/14/2005

John A. Gelardi

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38235 7590 12/09/2010  
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EXAMINER

LALLI, MELISSA LYNN

ART UNIT

PAPER NUMBER

3728

NOTIFICATION DATE

DELIVERY MODE

12/09/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketadministrator@mwv.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/556,531	<b>Applicant(s)</b> GELARDI ET AL.	
	<b>Examiner</b> MELISSA L. LALLI	<b>Art Unit</b> 3728	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 January 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This is in response to applicant's amendment wherein claims 3, 7, and 8 have been amended and claims 10-17 have been added. Therefore, claims 3-17 are pending.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 6, 2010 has been entered.

### ***Specification***

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01 (o). Correction of the following is required: the limitations "the strip section has a width at least as great as twice the tray thickness" as stated in claims 10 and 13 and "the strip section has a width of at least one half the stack height" as stated in claims 11 and 14 do not appear to be supported by the specification. Although the drawings depict width/thickness for the features, one is not able to ascertain the specified limitations solely from the provided drawings.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 10, 11, 13, and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitations "the strip section has a width at least as great as twice the tray thickness" as stated in claims 10 and 13 and "the strip section has a width of at least one half the stack height" as stated in claims 11 and 14 are considered new matter because there is no support for the specific language in the original specification.

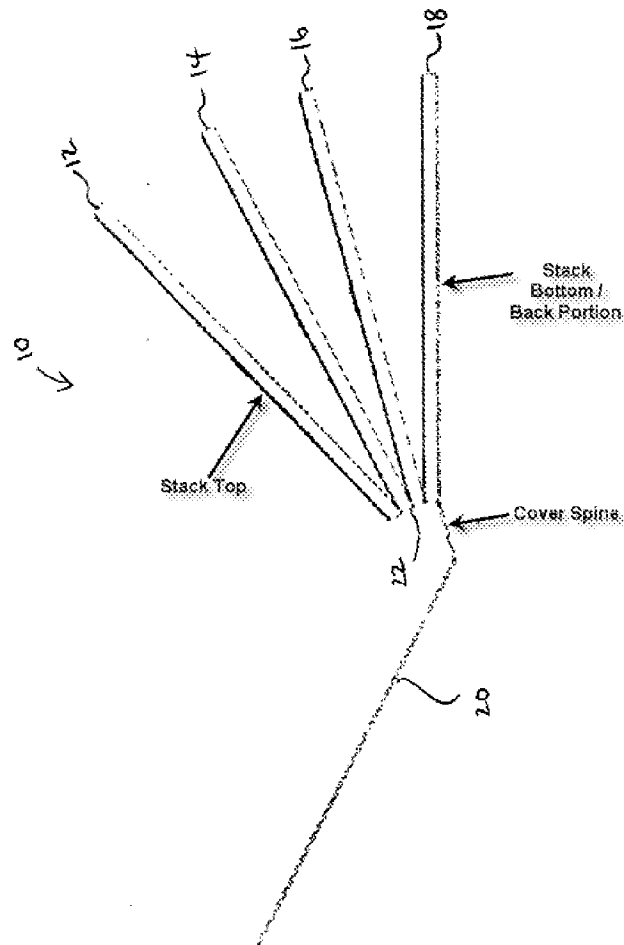
***Claim Rejections - 35 USC § 103***

7. Claims 3-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0106814 to Gelardi et al. (Gelardi) in view of DE 20008218 to Petermann GmbH & Co. KG (Petermann).

Regarding claims 3, 4, and 7, Gelardi discloses a package (10) for storing discs or articles comprising a stacked array of disc trays (12, 14, 16, 18) joined along a spine (22) and defining a stack top, stack bottom, and a stack height. The disc trays are substantially planar elements. A cover is disclosed having a front portion (20) and a back portion separated by a cover spine having a width equal to the stack height (fig. 5).

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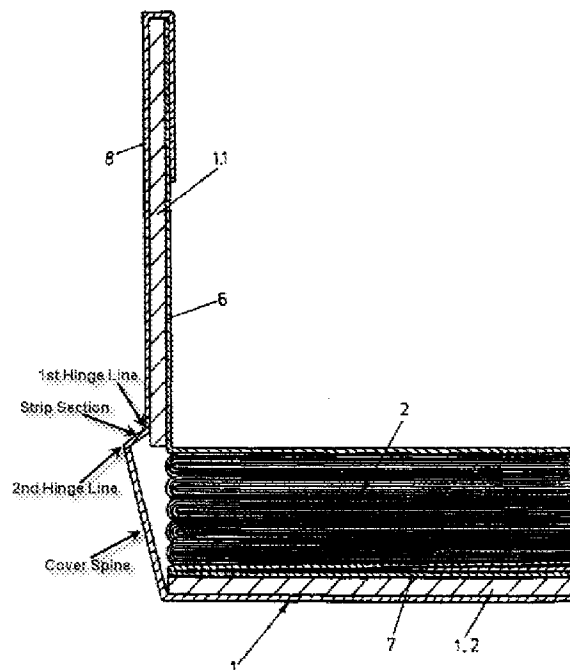
The back portion is fixedly attached to the stack bottom (fig. 6) and the front portion of the cover is free from attachment to the stack and may be separated from engagement with the stack when the cover is moved into an open position (see below).



Gelardi does not disclose the back portion of the cover including a strip section that is connected to the cover spine along a first hinge line and connected to the back cover portion along a second hinge line. However, Petermann discloses a similarly bound package (fig. 1) with a front cover portion (1) and a back cover portion (8). The front portion and back portion are separated by a cover spine. The back portion

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includes a strip section that is connected to the cover spine along a first hinge line and connected to the back portion along a second hinge line (see below). It would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated the strip section of Petermann on the back portion of Gelardi in order to allow a problem-free and unhindered opening in addition to the planar elements lying flat when opened as taught by Petermann. As per the modification, the strip section is free from attachment to the stack and may be separated from engagement with the stack as only the back portion of the cover of Gelardi is attached to the stack.



Regarding claim 5, Gelardi discloses the cover as a jacket (20) which appears to be a single ply substrate; however, if there is any doubt, it would have been obvious to

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one having ordinary skill in the art at the time of the invention that the jacket could be formed from a single ply substrate as a matter of design choice as such structures are old and conventional in the art for simplification of the manufacturing process.

Regarding claim 6, Gelardi discloses the back over portion being adhered to the stack bottom (paragraph [0035], lines 7-9).

Regarding method claim 8, all recited structures of the package are disclosed by Gelardi by Petermann as is discussed in detail in the rejection of claim 3 above. The method of making such a package is rendered obvious to one having ordinary skill in the art since all the claimed structures are present in the Gelardi/Petermann package.

Regarding method claim 9, Gelardi discloses the back cover section being mounted to the stack bottom (paragraph [0035], lines 7-9). Petermann also discloses elements of the package being bonded together with adhesive. Applying adhesive is obvious to one of ordinary skill in the art as a method of mounting objects together.

Regarding claims 12 and 15-17, all recited structures of the package are disclosed by Gelardi and Petermann as is discussed in detail in the rejection of claims 3-6 above. With respect to the limitation "wherein with the package placed on a flat surface, and having less than half of the disc trays moved into an open position adjacent the front cover portion, the strip section remains in facing contact with and parallel to the stack bottom, and wherein with the package placed on a flat surface, and having more than half of the disc trays moved into an open position adjacent the front cover portion, the strip section moves away from facing contact with the stack bottom",

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the structures disclosed by the combination of Gelardi and Petermann would inherently/obviously perform the functions described in the limitation.

Regarding claims 10, 11, 13, and 14, Gelardi and Petermann disclose each tray having a tray thickness and the strip section having a width; however, it is unclear if Gelardi and Petermann disclose the width of the strip section being at least as great as twice the tray thickness and being at least one half the stack height. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the strip section having a width at least as great as twice the tray thickness and at least one half the stack height, if it is not already doing so, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Additionally, it would have been an obvious matter of design choice to adjust the width of the strip section according to the tray thickness and stack height, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

### ***Response to Arguments***

8. Applicant's arguments filed January 6, 2010 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the



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claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, applicant argues that there is no reasonable expectation of success when Petermann does not explain the function of the 3-mm margin. The examiner respectfully disagrees in that a reasonable motivation is provided by Petermann. Although it is unclear whether Petermann explicitly states a specific purpose of the "3-mm wide margin", as stated in the final office action, the disclosure of Petermann generally teaches that it is desirable to create a binding structure which allows a problem-free and unhindered opening of the book in addition to the planar elements or pages lying flat when opened. All of the structures disclosed in Petermann unify to contribute to this purpose; hence, it is reasonable to modify Gelardi's back cover by adding the strip section of Petermann which is specifically stated as being free of any binding to the planar elements or pages.

In response to applicant's argument that Gelardi's having only one cover attached to the stack already allows for easy opening of the book, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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Furthermore, the addition of Petermann's strip section to Gelardi would not detract from or duplicate its function. Instead, it would further facilitate problem-free and unhindered opening of the book, in addition to the planar elements lying flat when opened as is stated in the rejections above.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA L. LALLI whose telephone number is (571)270-5056. The examiner can normally be reached on Monday-Friday 7:30 AM-5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLL  
12/04/10

/JILA M MOHANDESI/  
Primary Examiner, Art Unit 3728

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